

REMARKS

Upon entry of the present amendment, several of the claims in the present application will have been amended while several claims will have been submitted for consideration by the Examiner. In addition, a number of claims will have been canceled.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant wishes to thank Examiner Pokrzywa for acknowledging Applicant's Claim of Priority and for confirming receipt of copies of the priority documents. Additionally, Applicant thanks Examiner Pokrzywa for considering each of the documents cited in the various Information Disclosure Statements filed in the present application by return of the initialed and signed PTO-1449 Forms accompanying each of these Information Disclosure Statements.

Applicant also notes the Examiner's objection to the drawings based on the informalities set forth by the Patent Office Draftsman on the PTO-948 Form attached to the Official Action. In response, Applicant is submitting, concurrently herewith, a Letter to the Draftsman together with formal copies of Figs. 5 and 13 with the noted informality (left margin) having been eliminated. Consideration of these drawings and withdrawal of the objection is respectfully requested, in due course.

P17948.A14

Turning to the merits of the outstanding Official Action in the present application, Applicant notes that the Examiner rejected claims 19-36 under 35 U.S.C. § 102(e) as being anticipated by OHTA (U.S. Patent No. 6,396,848). The Examiner asserted that OHTA discloses a communication apparatus connected to a terminal apparatus via a network with the communication apparatus comprising an e-mail transmitter and a file generator that generates a communication result file that includes a communication result of the e-mail transmission performed by the e-mail transmitter. The Examiner further asserted that OHTA stores a memory that discloses a communication result file as a structured document and made reference to Figs. 7 and 9 as well as column 13, line 58 through column 14, line 22. Applicant respectfully traverses the above rejection and submits that it is inappropriate. In particular, Applicant respectfully submits that the combination of features recited in Applicant's claims is not taught, disclosed nor rendered obvious by the reference of record in the present application.

Applicant also wishes to make of record a personal interview conducted between Applicant's undersigned representative, Examiner Pokrzywa and Mr. Tsuchiya who represents the Assignee of the present application. The above-noted interview was conducted on May 13, 2003 and Applicant respectfully thanks Examiner Pokrzywa for his kindness, courtesy and cooperation during the above-noted interview as well as for his knowledge of the features of the present invention and the disclosure of the reference applied thereagainst. The Examiner's attitude has significantly assisted Applicant in prosecution of the present application.

During the above-noted interview, Applicant's undersigned representative discussed the shortcomings and deficiencies of the reference applied by the Examiner against the claims of the present application. Applicant further showed Examiner Pokrzywa an amended version of claim 19 and discussed how the features of claim 19, as amended, clearly distinguish over the features of the cited reference. As a result of the discussion at the above-noted interview, the amendments to claim 19, submitted by the present Amendment have been modified to take into consideration several of the Examiner's concerns regarding the claim limitations and the disclosure of the reference.

As noted above, in the above-noted Official Action, the Examiner asserted that the file generator "generates a communication result file (history report) that includes a communication result of the e-mail transmission performed by the e-mail transmitter". Applicant respectfully submits that the Examiner's interpretation of the reference is incorrect. It is respectfully submitted that while OHTA does generate a communication result file, it does not contain a communication result of the e-mail transmission performed by the e-mail transmitter. Rather, as is quite clear from the drawings of OHTA and as was pointed out to the Examiner during the above-noted personal interview, the communication result file disclosed by OHTA relates only to facsimile communications. In this regard, Applicant's representative pointed out that Applicant's claim 19 requires that the communication result file include result of an e-mail transmission communication and that the communication result file be stored as an HTML file in the recited memory. At least these features, in the claimed combination, are not taught, disclosed nor rendered obvious by OHTA.

In particular, with reference to Fig. 7, in the mode column of the illustrated "communication history indices" it is clear that facsimile transmissions are stored therein, as indicated by the terms "G3" and "G3ECM". Similarly, the mode column of Fig. 9 clearly indicates facsimile transmissions. As can be seen by reference to Fig. 10, a facsimile is received in step 401 and the received information is stored in step 103, the history file is renewed in step 104 and thereafter an HTML page is generated. Thus, the HTML page does not relate to e-mail transmission. It is only after the creation of the HTML page and after the history file has been updated that the information is converted into e-mail and sent to an e-mail address corresponding to a sub-address of a lan system, as illustrated in steps 109, 110 and 107. Similarly in Fig. 11, an incoming e-mail (step 201) is converted and a facsimile transmission is performed (step 207). Thereafter, the history database is updated in accordance with the transmission result (step 208) of the facsimile transmission. Thus, it is quite apparent that there is no communication result file for e-mail transmissions. The so-called communication result file of OHTA is for facsimile transmissions.

Essentially the same points were made with respect to various other portions of the disclosure of the OHTA reference during the above-noted interview. In other words, Applicant pointed out that in terms of claim 19, OHTA does not disclose a file generator that generates a communication result file that is stored as an HTML file and that includes a result of e-mail transmission communications formed by the e-mail transmitter.

During the above-noted interview, the Examiner hypothesized that if an e-mail reception occurs in OHTA and thereafter the subject matter (i.e., the data) of the e-mail is

P17948.A14

converted and transmitted by facsimile, the communication result file of the facsimile transmission could be considered to read on the recitations of Applicant's claims. During the above-noted interview, Applicant pointed out that the language of Applicant's claims precludes this interpretation as the language explicitly requires that the communication result file include a result of the e-mail transmission communication performed by the e-mail transmitter. This is submitted to be distinct from a communication result file of a facsimile transmission.

In particular, Applicant pointed out that if in the scenario posited by the Examiner, the e-mail transmission is successfully completed while the facsimile transmission is not successfully completed, the communication result file would indicate unsuccessful completion whereas according to the features of the Applicant's invention, where the result file includes the result of an e-mail transmission performed by the e-mail transmitter, the result would indicate a successful completion because the e-mail transmission was successfully completed.

Thus, both the language of claim 19 as well as the above-noted divergent results of Applicant's invention define over the interpretation that the Examiner proposed for the OHTA reference.

At the conclusion of the interview, Applicant proposed modifying claim 19 to render the above-noted distinction clearer and the Examiner indicated that the changes proposed therein, and that are incorporated in the present claim 19, appear to define over the OHTA reference. In this regard, the language which Applicant utilizes in claim 19 reads "a file

P17948.A14

generator that generates a communication result file that includes a result of the e-mail transmission communication performed by the e-mail transmitter". Thus, it is clear that the results are of an e-mail transmission not of a facsimile transmission. Moreover, this change does not narrow the scope of the claim.

At the conclusion of the interview, the Examiner set forth on the Interview Summary Form that the Examiner initially agrees with Applicant with respect to the limitations and will reconsider the new claim language which would distinguish this feature. Accordingly, Applicant respectfully requests that the Examiner reconsider the rejection asserted against the claims in the present application and confirm the understanding of the present invention and the reference set forth during the above-noted interview as well as in the present Response by indicating the allowability of all the claims pending in the present application, in due course.

By the present Response, Applicant is submitting claims 37 and 38 for consideration by the Examiner. These claims define yet an additional feature of Applicant's invention. In this regard, the Examiner's attention is respectfully directed to Fig. 16 and the description associated therewith. In particular, claim 37 recites both an e-mail transmitter and a facsimile transmitter as well as a determiner that determines whether to perform an e-mail transmission to a destination by the e-mail transmitter or to perform a facsimile transmission to the destination by the facsimile transmitter. Additionally, claim 37 recites the file generator and the communication result file as an HTML file. These features, as have been previously set forth and as has been discussed during the above-noted interview, provide a

P17948.A14

basis for patentability. The additional features of claim 37 (and of method claim 38) provide yet additional basis for the patentability thereof in addition to the features discussed above with respect to claim 19. Accordingly, Applicant respectfully requests reconsideration of the outstanding rejection, consideration of the newly submitted claims as well as an indication of the allowability of all the claims in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended several claims, submitted several additional claims for consideration and canceled other claims. Applicant has further made of record a personal interview conducted between Applicant's undersigned representative and the Examiner during which interview various shortcomings of the reference were discussed and the operation of Applicant's invention described.

Applicant has discussed the shortcomings of the reference with respect to the recitations of the claims. Applicant has further discussed the features of Applicant's invention and has pointed out the shortcomings and deficiencies of the cited reference with respect thereto. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

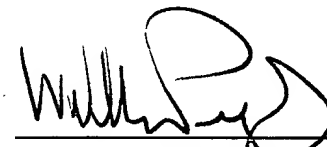
Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be

P17948.A14

considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

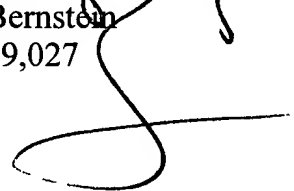
Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Junichi IIDA



Bruce H. Bernstein
Reg. No. 29,027

BN 33630



May 23, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191